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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,024	09/02/2003	Gregg M. Duthaler	H-357	2023
26245	7590	12/14/2004	EXAMINER	
DAVID J COLE E INK CORPORATION 733 CONCORD AVE CAMBRIDGE, MA 02138-1002			THOMAS, BRANDI N	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/605,024

Applicant(s)

DUTHALER ET AL.

Examiner

Brandi N Thomas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 and 28-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Detailed Action.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 17-27 in the reply filed on 11/15/04 is acknowledged.
2. Claims 1-16 and 28-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/15/04.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 17-24, 26, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Holman et al. (US 2003/0025855 A1).

Regarding claim 17, Holman et al. discloses, in figure 1, an article of manufacture comprising: a layer of a solid electro-optic medium (130) having first and second surfaces on opposed sides thereof, a first adhesive layer (180) on the first surface of the layer of solid electro-optic medium (130), a release sheet (190) disposed on the opposed side of the first adhesive layer

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(180) from the layer of solid electro-optic medium (130) (sections 0090, 0092, and 0093) and Hoffman et al. does not explicitly teach a second adhesive layer on the second surface of the layer of solid electro-optic medium. However, Holman et al. does disclose that applying an adhesive to the backplane is possible. It is inherent to use a second layer of adhesive to secure the substrate and circuitry to the electro-optic medium (section 0087).

Regarding claim 19, Holman et al. discloses, in figure 1, an article of manufacture wherein the electro-optic medium is an electrophoretic medium (130) comprising a plurality of capsules (140), each capsule comprising a suspending fluid, a plurality of electrically charged particles (150 and 160) suspended in the suspending fluid and capable of moving therethrough on application of an electric field to the suspending fluid (sections 0008 and 0092), and a capsule wall surrounding the suspending fluid and the electrically charged particles (150 and 160) (section 0009).

Regarding claim 20, Holman et al. discloses, in figure 1, an article of manufacture wherein the first adhesive layer extends beyond the periphery of the layer of electro-optic medium (figure 1) except for a second adhesive layer on the second surface of the layer of solid electro-optic medium. However, Holman et al. does disclose that applying an adhesive to the backplane is possible. It is inherent to use a second layer of adhesive to secure the substrate and circuitry to the electro-optic medium (section 0087).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 18, 21-24, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holman et al. (US 2003/0025855 A1).

Regarding claim 18, Holman et al. discloses, in figure 1, an article of manufacture except for a second release sheet disposed on the opposed side of the second adhesive layer from the layer of solid electro-optic medium. It would have been obvious to include a second release sheet, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art (St. Regis Paper Co. v. Bemis Co., 193 USPQ 8). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a second release sheet for the purpose of forming a display.

Regarding claim 21, Holman et al. discloses, in figure 1, an article of manufacture comprising: a layer of a solid electro-optic medium (130) having first and second surfaces on opposed sides thereof, a first release sheet (190) covering the first surface of the layer of solid electro-optic medium (130) (sections 0090, 0092, and 0093) except for a second release sheet disposed on the opposed side of the second adhesive layer from the layer of solid electro-optic medium. It would have been obvious to include a second release sheet, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art (St. Regis Paper Co. v. Bemis Co., 193 USPQ 8). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a second release sheet for the purpose of forming a display.

Regarding claim 22, Holman et al. discloses, in figure 1, an article of manufacture wherein the electro-optic medium is an electrophoretic medium (130) comprising a plurality of capsules (140), each capsule (140) comprising a suspending fluid, a plurality of electrically charged particles (150 and 160) suspended in the suspending fluid and capable of moving therethrough on electric field to the suspending application of an fluid (sections 0008 and 0092), and a capsule wall surrounding the suspending fluid and the electrically charged particles (section 0009).

Regarding claims 23 and 26, Holman et al. discloses, in figure 1, a process for forming an electro-optic display, the process comprising: providing an article of manufacture comprising a layer of a solid electro-optic medium (130) having first and second surfaces on opposed sides thereof, a first adhesive layer (180) on the first surface of the layer of solid electro-optic medium (130), a release sheet (190) disposed on the opposed side of the first adhesive layer (180) from the layer of solid electro-optic medium (130) (sections 0090, 0092, and 0093), removing the release sheet and from the front subassembly (section 0093), laminating the front subassembly via the first adhesive layer (180) to a backplane comprising at least one electrode (120), thereby forming the electro-optic display (sections 0087 and 0093) except for a second adhesive layer on the second surface of the layer of solid electro-optic medium and laminating the article to a front substrate via the second adhesive layer, thereby forming a front subassembly. However, Holman et al. does disclose that applying an adhesive to the backplane is possible. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a second layer of adhesive securing the substrate and circuitry to the electro-optic medium (section 0087). Regarding claim 26, Holman et al. discloses the claimed invention

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except for a second release sheet disposed on the opposed side of the second adhesive layer from the layer of solid electro-optic medium. It would have been obvious to include a second release sheet, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art (*St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a second release sheet for the purpose of forming a display.

Regarding claim 24, Holman et al. discloses, in figure 1, a process for forming an electro-optic display, wherein the front substrate (110) comprises an electrode (120) (section 0090).

Regarding claim 27, Holman et al. discloses, in figure 1, an article of manufacture wherein the first adhesive layer extends beyond the periphery of the layer of electro-optic medium (figure 1) except for a second adhesive layer on the second surface of the layer of solid electro-optic medium. However, Holman et al. does disclose that applying an adhesive to the backplane is possible. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a second layer of adhesive securing the substrate and circuitry to the electro-optic medium (section 0087).

5. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holman et al. (US 2003/0025855 A1) as applied to claim 23 above, and further in view of Kazlas et al. (US 2004/0014265A1).

Regarding claim 25, Holman et al. discloses the claimed invention except for a color filter array. Kazlas et al. shows that it is known to provide a color filter array for providing color to the display (sections 0077 and 0080). Therefore it would have been obvious to someone of

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ordinary skill in the art at the time the invention was made to combine the teaching of Holman et al. with the color filter of Kazlas et al. for the purpose of providing color to the display (sections 0077 and 0080).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandi N Thomas whose telephone number is 571-272-2341. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on 571-272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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December 13, 2004


RICKY MACK
PRIMARY EXAMINER